

REMARKS

I. Amendments

By this amendment, claims 19, 20, 22, 23, 25, 26, 34-36 and 39 have been amended and claims 1, 2, 4-12, 14-18, 28, 40 and 45 have been cancelled.

Typographical errors have also been corrected throughout the specification.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

No change of inventorship is necessitated by this amendment.

II. Request for Consideration of a Previously Submitted Information Disclosure Statement

An Information Disclosure Statement to disclose fifteen references (A1-A15) was filed on March 19, 2002 when the application was originally filed. Receipt of the Information Disclosure Statement was acknowledged on the Notice of Acceptance mailed January 16, 2003, so Applicants believe that a copy of the IDS is in the file. Should the IDS and references be missing from the Examiner's files, the Examiner is respectfully requested to contact Applicants' Attorney so that copies can be provided by fax.

Consideration of the previously submitted Information Disclosure Statement is respectfully requested.

III. Discussion of the Office Action Summary

In the Office Action Summary, claims 1-45 were listed as pending, and claims 1-17, 28, 35-39 and 45 were listed as withdrawn. However, a Preliminary Amendment was filed on March 19, 2002 when the application was originally filed. In the Preliminary Amendment, several claims were cancelled. Claims 3, 13, 21, 24, 27, 29-33, 37 and 38 are therefore neither pending nor withdrawn.

Since claims 39-45 were added by Preliminary Amendment, and the added claims were listed as pending, Applicants are uncertain as to whether their Preliminary Amendment was completely considered and entered. Clarification is requested.

Receipt of the Preliminary Amendment was acknowledged on the Notice of Acceptance mailed January 16, 2003, so Applicants believe that a copy of the Preliminary Amendment is in the file. Should the Preliminary Amendment be missing from the Examiner's files, the Examiner is respectfully requested to contact Applicants' Attorney so that copies can be provided by fax.

IV. Discussion of the Restriction Requirement

Applicants wish to thank the Examiner for the consolidation of some of the previous Groups.

Applicants hereby confirm their election of Group II (claims 18-26, 34 and 40-44). Many of the withdrawn claims have been cancelled by this amendment. Furthermore, by this amendment the independent claims 19, 22 and 25 have been amended to reflect the elected invention, wherein X' is -CONR^{8c} -, Ar ' is the first formula and Y and R² do not form a ring. Dependent claim 34 has also been amended to cancel non-elected compounds.

Furthermore, Applicants have amended claims 35, 36 and 39 to be dependent upon claim 19. Applicants respectfully request the Examiner's reconsideration of the withdrawal of these newly dependent claims.

Claims 20, 34 and 41 depend upon claim 19; claims 23 and 42 depend upon claim 22 and claims 26, 43 and 44 depend upon claim 25.

Therefore, Applicants submit that the pending claims as amended are in conformance with the restriction requirement.

V. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph

Claims 18-20, 22, 23, 25 and 26 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite for three reasons. Applicants respectfully traverse the rejection. Each aspect of the rejection will be discussed separately below.

In the first aspect of the rejection, the Examiner has objected to the phrase “nitrogen-containing hetero ring” in the definition of the option wherein R¹ and R² form a ring. By this amendment, the objected-to phrase has been replaced by a more descriptive phrase in claims 19, 22 and 25, in accordance with the teachings of the specification (page 53, line 25 - page 54, line 10 *inter alia*).

In the second aspect of the rejection, the phrase “which may have substituents” has been objected to in the claims. By this amendment, specific substituents have been recited in the independent claims 19, 22 and 25, in accordance with the teachings of the specification (page 22, line 12 – page 40, line 18; page 27, line 29 – page 28, line 5; and page 57, lines 16-22 *inter alia*). Applicants submit that this aspect of the rejection has been overcome.

In the third aspect of the rejection, the term “spacer “ has been objected to in claims 18-20, 22, 23, 25 and 26. Claim 18 has been cancelled, and the term has been deleted from claims 19, 22 and 25. Claim 20 depends upon claim 19; claim 23 depends upon claim 22 and claim 26 depends upon claim 25. The modification is in accordance with the teachings of the specification (page 49, lines 10-18 *inter alia*). Applicants submit that this aspect of the rejection has been overcome.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

VI. Discussion of the Rejection under 35 U.S.C. Sec. 102(e) over Fink *et al*.

Claims 18-20, 22, 23 and 40-42 have been rejected under 35 U.S.C. Sec. 102(a) as allegedly anticipated in view of Fink *et al*, (U.S. Patent No. 6,197,798). Applicants respectfully traverse the rejection.

By this amendment, claims 18 and 40 have been cancelled.

Applicants submit that the aspects of their invention as set forth in independent claims 19 and 22 is not anticipated by the cited reference, as the “n” in claims 19 and 22 has been limited to “2-4”, and “Y” has been limited to “C₁₋₃ alkylene”. The compounds (z), (aa), (bk), (bl), (bq), (ci) and (bh) of US 6,197,798 all have dihydroindene wherein “n” is “1”, and “Y” is not “C₁₋₃

alkylene". Therefore, the cited reference is non-anticipatory as the cited compounds are structurally different from the compounds of claims 19 and 22 as amended.

Claims 20 and 41 depend upon claim 19 and claims 23 and 42 depend upon claim 22. Applicants submit that the more specific dependent claims are also not anticipated for the reason provided above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 102(e) rejection over Fink *et al.*

VII. Discussion of the Rejection under 35 U.S.C. Sec. 102(b) over Werbel *et al.*

Claims 18 and 40 have been rejected under 35 U.S.C. Sec. 102(b) as allegedly anticipated in view of Werbel *et al.*, (Chem. Abs. 73: 109549). Applicants respectfully traverse the rejection.

By this amendment, claims 18 and 40 have been cancelled, thereby rendering the rejection moot.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 102(b) rejection over Werbel *et al.*

VIII. Discussion of the Rejection under 35 U.S.C. Sec. 102(b) over Preregaard *et al.*

Claims 18-20, 22, 23, 25, 26 and 40-44 have been rejected under 35 U.S.C. Sec. 102(b) as allegedly anticipated in view of Preregaard *et al.*, (Chem. Abs. 124: 232261). Applicants respectfully traverse the rejection.

By this amendment, claims 18 and 40 have been cancelled.

In independent claims 19 and 22 as amended, the "n" has been limited to "2-4". The compounds having RN 174776-05-7 and 174776-06-8 described in Chem. Abstract 124: 232261 have dihydroindene wherein "n" is "1". Therefore, these compounds are structurally different from the compounds of claims 19 and 22 after amendment. In addition, Chem. Abstract 124: 232261 does not describe or suggest substitution of dihydroindene (9-membered ring) to the 10- to 12-membered rings of claims 19 and 22.

In independent claim 25 as amended, the dihydronaphthalene derivatives are structurally different from the dihydroindene derivatives described in Chem. Abstract 124: 232261. In addition, Chem. Abstract 124: 232261 does not describe or suggest substitution of dihydroindene (9-membered ring) to the 10-membered ring of claim 25.

Claims 20 and 41 depend upon claim 19, claims 23 and 42 depend upon claim 22 and claims 26, 43 and 44 depend upon claim 25. Applicants submit that the more specific dependent claims are also not anticipated for the reason provided above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 102(b) rejection over Preregaard *et al.*

IX. Discussion of the Rejection under 35 U.S.C. Sec. 103(a) over Fink *et al.*

Claims 18-20, 22, 23, 34 and 40-42 have been rejected under 35 U.S.C. Sec. 103(a) as allegedly obvious in view of Fink *et al.*, (U.S. Patent No. 6,197,798). Applicants respectfully traverse the rejection.

By this amendment, claims 18 and 40 have been cancelled.

Applicants do not believe that the aspects of their invention set forth in independent claims 19 or 22 are taught or suggested by the cited reference. Applicants hereby incorporate the argument of Sec. VI above, which illustrates some differences between compounds of the cited art and compounds of the present invention.

Claims 20, 34 and 41 depend upon claim 19 and claims 23 and 42 depend upon claim 22. Applicants submit that the more specific dependent claims are also not rendered obvious for the reason provided above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over Fink *et al.*

X. Discussion of the Objections to the Claims

Claims 18, 19, 22, 25 and 34 have been objected to by the Examiner as improper with respect to the options for the substituents for variables X' and Ar'.

By this amendment, claim 18 has been cancelled.

Claims 19, 22, 25 and 34 have been modified in accordance with the restriction requirement. Applicants assert that the pending claims as amended are not improper.

Therefore Applicants respectfully request withdrawal of the objection to the claims.

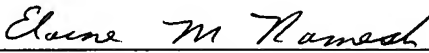
XI. Conclusion

Reconsideration of the claims as amended and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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